REMARKS

Applicants respectfully request entry of the foregoing amendments before examination of the present application. In response to the restriction requirement mailed May 6, 2003, applicants elect Group I with traverse.

Applicants contend that the Examiner has failed to establish that the restriction is proper under applicable PTO rules. According to the MANUAL OF PATENT EXAMINATION PROCEDURE,

> an application may properly be restricted to one of two or more inventions only if they are able to support separate patents and they are either independent or distinct. If the search of the entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though** it includes claims to independent or distinct inventions.... There are two criteria for a proper requirement for restriction between two patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; **and** (B) There must be a serious burden on the examiner if restriction is required." (*Id.,* emphasis added, citations omitted.)

MPEP § 803 (emphasis added; citations omitted). Applicants urge that the Examiner has not offered sufficient evidence to demonstrate either prongs (A) or (B) and therefore the restriction requirement is improper.

To satisfy prerequisite (A), that the invention is "distinct" for restriction purposes, the examiner has offered only the following statement. "Inventions of Groups I-III are drawn to independent and/or patentably distinct compounds since each of these compounds possess different structure (e.g., primary, secondary and tertiary structure) and/or physio-chemical properties, and/or are capable of separate manufacture and/or use. These compounds do not share a common structure which elicits a common activity."

Advancing no argument that the compounds possess different properties or are capable of separate manufacture or use, the Examiner is heard to contend that the Groups are distinct only because "they do not share a common structure which elicits a common activity." Yet each of the recited SEQ ID NOs: 1-3 come from the N-terminal domain of the p43 protein. See specification at page 5. Thus, SEQ ID NO: 1

corresponds to residues 1 to 147, SEQ ID NO: 2 to residues 1 to 108, and SEQ ID NO: 3 to residues 91 to 256.

Accordingly, all of these sequences are derived from the same protein and share overlapping amino acid residues. Moreover, all of these sequences function as immunological enhancement agents. In other words, the three amino acid sequences do share a common structure, which elicits a common activity. It necessarily follows that the Examiner's rationale for restriction is improper.

Applicants also would point out that Groups I-III can be searched together without a serious burden, and therefore the Examiner has failed to establish requisite prong (B) of MPEP § 803. There are only three independent claims, all of which relate to SEQ ID NOs: 1-3. The Examiner has classified Groups I-III as all being in class 530, subclass 350. All of these groups are in the same class and subclass, and they therefore implicate the same search. By the same token, there cannot be a serious burden to search, contrary to the Examiner's stated position.

Finally, applicants note that the assignee, Imagene Co. Ltd., is a small entity of limited resources and forcing the assignee to incur the costs of filing three separate patent applications on these substantially similar sequences will be a significant financial burden.

For the reasons given above, applicants respectfully request withdrawal of the restriction requirement of Groups I-III and examination of all pending claims.

Applicants await an Office Action on the merits. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date June 9, 2003

By _____

Matthew E. Mulkeen
Registration No. 44,250

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5446
Facsimile: (202) 672-5399